

REMARKS

Claims 1-7 are pending and under consideration. Further reconsideration is requested based on the following remarks.

Response to Arguments:

The Applicants appreciate the consideration given to their arguments. The Applicants, however, are disappointed that their arguments were not found to be persuasive.

Section 10 at page 6:

The Office Action asserts in section 10, at page 6 that:

To the extent that applicant is arguing that the references applied in the rejection fail to use the same names for certain elements as the names used by applicant, the argument is irrelevant, as it is noted that the disclosure in a reference must show the claimed elements arranged in the same order as in the claims, but ***need not be in the identical words*** as used in the claims in order to be anticipatory. See *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990).

The Applicants agree that, in order to anticipate the claims, Anderson would need to show the claimed elements arranged in the same order as they are recited in the claims. The Applicants, moreover, are not arguing simply that U.S. Patent No. 5,581,682 to Anderson *et al.*, (hereinafter "Anderson") fails to use the same *names* for certain elements as the names used by Applicants. The Applicants, rather, are arguing that Anderson does not show all of the claimed elements in the first place, let alone all of the claimed elements arranged in the same order as they are recited in the claims.

Under the provisions of M.P.E.P. § 2131, furthermore, a reference must teach every element of a claim in order to anticipate a claim. As provided therein:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."
Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Since each and every element as set forth in either claim 3, claim 5, or claim 7 are not to be found in Anderson, Anderson cannot anticipate claims 3, 5, or 7, *Verdegaal Bros. v. Union Oil Co. of California*.

M.P.E.P. § 2131 also requires the identical invention to be shown in as complete detail as is contained in the claim. As provided therein:

"The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Since neither claim 3, claim 5, nor claim 7 is shown in Anderson in as complete detail as is contained in the claims, Anderson cannot anticipate claims 3, 5, or 7, *Richardson v. Suzuki Motor Co.*

Finally, M.P.E.P. § 2131 requires the elements to be arranged as required by the claim. As provided therein:

The elements must be arranged as required by the claim, but this is not an ipissimis verbis test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Since Anderson does not show the elements of either claim 3, claim 5, or claim 7 arranged as required by the claim, Anderson cannot anticipate claims 3, 5, or 7, *In re Bond*.

M.P.E.P. § 2143.03, similarly, requires all the claim limitations to be taught or suggested by the prior art. As provided therein:

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

Since all of the limitations of claim 1 are not taught or suggested by Anderson, a prima facie case of obviousness of claim 1 has not been established, *In re Royka*.

Section 11 at page 6:

The Office Action asserts in section 11, at page 6 that:

Regarding the argument that Anderson et al. fail to disclose an auxiliary storage unit storing a dictionary which contains the at least one character string of non-disclosure in association with a least one corresponding reason, Anderson et al. indeed disclose an auxiliary storage units during a dictionary which contains the at least one character string of nondisclosure in association with a least one corresponding reason. See, for example, the abstract and claims 1 to 5.

This is submitted to be without basis. The Abstract of Anderson mentions no dictionary at all, let alone an auxiliary storage unit "storing a dictionary which contains said at least one character string of non-disclosure in association with at least one corresponding reason," as recited in, for example, claims 3 and 5. There are only two sentences in the Abstract of Anderson. The first sentence of the Abstract of Anderson, in particular, describes only:

This invention is a method for annotating and redacting a final-form document

archived in a computerized system where it is important that the fidelity of the final form document is preserved.

As may be seen from the first sentence of the Abstract of Anderson, no dictionary is mentioned at all, let alone an auxiliary storage unit "storing a dictionary which contains said at least one character string of non-disclosure in association with at least one corresponding reason," as recited in, for example, claims 3 and 5.

The second sentence of the Abstract of Anderson, similarly, describes only:

More particularly, this method allows final-form documents containing objects such as texts, graphics and images to be annotated or redacted by other objects carried in the same data stream without compromising the integrity of the original document.

As may be seen from the second sentence of the Abstract of Anderson, no dictionary is mentioned at all, let alone an auxiliary storage unit "storing a dictionary which contains said at least one character string of non-disclosure in association with at least one corresponding reason," as recited in, for example, claims 3 and 5.

None of claims 1-5 of Anderson recite an auxiliary storage unit "storing a dictionary which contains said at least one character string of non-disclosure in association with at least one corresponding reason," either.

Anderson, rather, is about overlaying objects representing an annotation or redaction on a final form document to be merged in the same data stream as the final form document, as described at column 2, lines 25-28. Anderson does not describe dictionaries at all, let alone an "auxiliary storage unit storing a dictionary which contains said at least one character string of non-disclosure in association with at least one corresponding reason." Claim 1 of Anderson, for example, recites:

1. A method for storing documents and information associated with said documents, said method comprising the steps of:
converting a document to a document data stream, said document data stream comprised of document data and a plurality of structured fields;
converting information associated with said document to an information data stream;
combining said document data stream with said information data stream to form a combined data stream, leaving said document data in said combined data stream unchanged;
modifying at least one of said structured fields in said combined data stream by adding an include structure to indicate that said information data stream has been included in said combined data stream; and
storing said combined data stream.

Claim 1 may thus be seen to relate to a method for storing documents and information associated with said documents by modifying at least one of said structured fields in said combined data stream by adding an include structure to indicate that said information data stream has been included in said combined data stream. No structure analogous to an "auxiliary storage unit storing a dictionary which contains said at least one character string of non-disclosure in association with at least one corresponding reason," appears in claim 1 of Anderson, whether literally or equivalently, at all.

Claim 2 of Anderson, similarly, recites:

2. A method as in claim 1 wherein a first of said structured fields is associated with a first portion of said information data stream, and said first structured field indicates whether said first portion of said information data stream is an annotation of said document data stream or a redaction of said document data stream.

Claim 2 of Anderson may thus also be seen to relate to the method for storing documents and information associated with said documents of claim 1. No structure analogous to an "auxiliary storage unit storing a dictionary which contains said at least one character string of non-disclosure in association with at least one corresponding reason," appears in claim 2 of Anderson, whether literally or equivalently, at all.

Claim 3 of Anderson, similarly, recites:

3. A method as in claim 1 wherein:
a first group of said plurality of structured fields comprises a plurality of "begin flags", each of said flags indicating the beginning of a portion of said document data stream corresponding to the beginning of a portion of said document;
a second group of said plurality of said structured fields comprises a plurality of "end flags", each of said end flags indicating the end of a portion of said document data stream corresponding to the end of a portion of said document;
a third group of said plurality of structured fields being "indicator flags", each of said indicator flags being associated with one of said beginning flags and one of said end flags, said indicator flags indicating specific conditions; and
said modification of at least one of said structured fields comprising modifying a first of said indicator flags, said first indicator flag being associated with a first of said beginning flags and a first of said end flags, said modified indicator flags indicating that a first portion of said information data stream is to be associated with said portion of said document data stream corresponding to said first beginning flag and said first end flag.

Claim 3 of Anderson may thus also be seen to relate to the method for storing documents and information associated with said documents of claim 1. No structure analogous to an "auxiliary storage unit storing a dictionary which contains said at least one character string of non-disclosure in association with at least one corresponding reason," appears in claim 3 of

Anderson, whether literally or equivalently, at all.

Claim 4 of Anderson, similarly, recites:

4. A method as defined in claim 3 wherein said modified first indicator flag additionally indicates a security level of said first portion of said information data stream.

Claim 4 of Anderson may thus also be seen to relate to the method for storing documents and information associated with said documents of claim 1. No structure analogous to an "auxiliary storage unit storing a dictionary which contains said at least one character string of non-disclosure in association with at least one corresponding reason," appears in claim 4 of Anderson, whether literally or equivalently, at all.

Claim 5 of Anderson, similarly, recites:

5. A method as defined in claim 3 wherein said modified indicator flags additionally indicate the location of said associated information within said first portion of said information data stream.

Claim 5 of Anderson may thus also be seen to relate to the method for storing documents and information associated with said documents of claim 1. No structure analogous to an "auxiliary storage unit storing a dictionary which contains said at least one character string of non-disclosure in association with at least one corresponding reason," appears in claim 5 of Anderson, whether literally or equivalently, at all.

Section 12 at pages 6 and 7:

The Office Action asserts in section 12, at pages 6 and 7 that:

Regarding the argument that Anderson et al. fail to disclose embedding a tag and the reason for non-disclosure corresponding to the character string in the document, Anderson et al. indeed disclose embedding a tag and the reason for non-disclosure corresponding to the character string in the document. See, for example, the abstract and claims 1-5.

This is submitted to be without basis. The Abstract of Anderson does not mention "embedding a tag and the reason of non-disclosure corresponding to the character string in the document," as recited in, for example, claims 3 and 5.

None of claims 1-5 of Anderson recite "embedding a tag and the reason of non-disclosure corresponding to the character string in the document," either.

Claim 1 of Anderson, as discussed above, relates to a method for storing documents and information associated with said documents by modifying at least one of said structured fields in

said combined data stream by adding an include structure to indicate that said information data stream has been included in said combined data stream. Nothing analogous to "embedding a tag and the reason of non-disclosure corresponding to the character string in the document," appears in claim 1 of Anderson, whether literally or equivalently, at all.

Claim 2 of Anderson, as discussed above, relates to the method for storing documents and information associated with said documents of claim 1. Nothing analogous to "embedding a tag and the reason of non-disclosure corresponding to the character string in the document," appears in claim 2 of Anderson, whether literally or equivalently, at all.

Claim 3 of Anderson, as discussed above, relates to the method for storing documents and information associated with said documents of claim 1. Nothing analogous to "embedding a tag and the reason of non-disclosure corresponding to the character string in the document," appears in claim 3 of Anderson, whether literally or equivalently, at all.

Claim 4 of Anderson, as discussed above, relates to the method for storing documents and information associated with said documents of claim 1. Nothing analogous to "embedding a tag and the reason of non-disclosure corresponding to the character string in the document," appears in claim 4 of Anderson, whether literally or equivalently, at all.

Claim 5 of Anderson, as discussed above, relates to the method for storing documents and information associated with said documents of claim 1. Nothing analogous to "embedding a tag and the reason of non-disclosure corresponding to the character string in the document," appears in claim 5 of Anderson, whether literally or equivalently, at all.

Section 13 at page 7:

The Office Action asserts in section 13, at page 7 that:

Regarding the argument that Anderson et al. fail to disclose replacing the character string to which the tag of non-disclosure is given to a meaningless character string, when the document is accessed, Anderson et al. indeed disclose replacing the character string to which the tag of non-disclosure is given to a meaningless character string, when the document is accessed. See, for example, the abstract and claims 1 to 5.

This is submitted to be without basis. The Abstract of Anderson does not mention "replacing the character string to which the tag of non-disclosure is given to a meaningless character string, when the document is accessed," as recited in, for example, claims 3 and 5.

None of claims 1-5 of Anderson recite "replacing the character string to which the tag of non-disclosure is given to a meaningless character string, when the document is accessed,"

either.

Claim 1 of Anderson, as discussed above, relates to a method for storing documents and information associated with said documents by modifying at least one of said structured fields in said combined data stream by adding an include structure to indicate that said information data stream has been included in said combined data stream. Nothing analogous to "replacing the character string to which the tag of non-disclosure is given to a meaningless character string, when the document is accessed," appears in claim 1 of Anderson, whether literally or equivalently, at all.

Claim 2 of Anderson, as discussed above, relates to the method for storing documents and information associated with said documents of claim 1. Nothing analogous to "replacing the character string to which the tag of non-disclosure is given to a meaningless character string, when the document is accessed," appears in claim 2 of Anderson, whether literally or equivalently, at all.

Claim 3 of Anderson, as discussed above, relates to the method for storing documents and information associated with said documents of claim 1. Nothing analogous to "replacing the character string to which the tag of non-disclosure is given to a meaningless character string, when the document is accessed," appears in claim 3 of Anderson, whether literally or equivalently, at all.

Claim 4 of Anderson, as discussed above, relates to the method for storing documents and information associated with said documents of claim 1. Nothing analogous to "replacing the character string to which the tag of non-disclosure is given to a meaningless character string, when the document is accessed," appears in claim 4 of Anderson, whether literally or equivalently, at all.

Claim 5 of Anderson, as discussed above, relates to the method for storing documents and information associated with said documents of claim 1. Nothing analogous to "replacing the character string to which the tag of non-disclosure is given to a meaningless character string, when the document is accessed," appears in claim 5 of Anderson, whether literally or equivalently, at all.

Reconsideration is thus requested.

Rejection under 35 U.S.C. § 102:

Claims 3-7 were rejected under 35 U.S.C. § 102(b) as anticipated by Anderson. The rejection is traversed. Reconsideration of the rejection is earnestly solicited.

The second clauses of claims 3 and 5 recite substantially:

Storing a dictionary which contains said at least one character string of non-disclosure in association with at least one corresponding reason.

Anderson neither teaches, discloses, nor suggests "storing a dictionary which contains said at least one character string of non-disclosure in association with at least one corresponding reason," as recited in claims 3 and 5. Anderson, rather, mentions no dictionary at all.

The third clauses of claims 3 and 5 recite substantially:

Embedding a tag and the reason of non-disclosure corresponding to the character string in the document.

Anderson neither teaches, discloses, nor suggests "embedding a tag and the reason of non-disclosure corresponding to the character string in the document," as recited in claims 3 and 5, either. In Anderson, rather, final-form documents are annotated or redacted *without* compromising the integrity of the original document. In particular, as described in the Abstract:

More particularly, this method allows final-form documents containing objects such as texts, graphics and images to be annotated or redacted by other objects carried in the same data stream without compromising the integrity of the original document.

Since Anderson wants to annotate or redact final-form documents without compromising the integrity of the original document, Anderson is not "embedding a tag and the reason of non-disclosure corresponding to the character string in the document" as recited in claims 3 and 5.

Anderson, furthermore, *maintains* the document's integrity. In particular, as described at column 2, lines 20-24:

The present invention embodies a method to store and retrieve final form documents which not only maintains the document's integrity but also overcomes the difficulties and inconvenience encountered in using an editor or merging and overlaying two files using links to an external file.

Since Anderson maintains the document's integrity, Anderson is not "embedding a tag and the reason of non-disclosure corresponding to the character string in the document" as recited in claims 3 and 5.

Furthermore, in Anderson, the contents of the original, underlying document as archived is *not* changed. In particular, as described at column 2, lines 42-47:

With both annotation and redaction, the contents of the original, underlying document as archived is not changed. However, a reviewer may see either the original document or the document with the annotations or redacted sections

included.

Since, in Anderson, the contents of the original, underlying document as archived is not changed, Anderson is not "embedding a tag and the reason of non-disclosure corresponding to the character string in the document" as recited in claims 3 and 5.

Anderson, furthermore, only wants to allow annotation of final form objects *without* changing the contents. In particular, as described at column 2, lines 65, 66, and 67:

This invention uses the overlay function but has added a "conditional processing" structure to allow annotation of final form objects without changing the contents.

Since Anderson only wants to allow annotation of final form objects without changing the contents, Anderson is not "embedding a tag and the reason of non-disclosure corresponding to the character string in the document" as recited in claims 3 and 5.

Finally, Anderson, uses a forms *overlay* structure to store the data. In particular, as described at column 5, lines 44 and 45:

The method of the invention uses the forms overlay structures in order to store the data.

Since Anderson uses a forms overlay structures to store the data, Anderson is not "embedding a tag and the reason of non-disclosure corresponding to the character string in the document" as recited in claims 3 and 5.

The fourth clauses of claims 3 and 5 recite substantially:

Replacing the character string to which the tag of non-disclosure is given to a meaningless character string, when the document is accessed.

Anderson neither teaches, discloses, nor suggests "replacing the character string to which the tag of non-disclosure is given to a meaningless character string, when the document is accessed," as recited in claims 3 and 5, either. Anderson, rather, positions *overlays* on the page based on *coordinate* data contained in the overlay reference. In particular, as described at column 3, lines 47-55:

With the current final form overlays, each annotation is stored as a separate data object in a library which is referenced from within the final form documents. When the final form document is presented, the referenced object is retrieved and merged with the specific data page. Overlays are then positioned on the page based on coordinate data contained in the overlay reference.

Since Anderson positions overlays on the page based on coordinate data contained in the overlay reference, Anderson is not "replacing the character string to which the tag of non-

disclosure is given to a meaningless character string, when the document is accessed" as recited in claims 3 and 5. Claim 3 and 5 are thus submitted to be allowable. Withdrawal of the rejection of claims 3 and 5 is earnestly solicited.

Claims 4 and 6 depend from claims 3 and 5, respectively, and add further distinguishing elements. The last clauses of claims 4 and 6, for example, recite:

Replacing the retrieved tag of non-disclosure with the tag for compulsory disclosure.

Anderson describes no *compulsory* disclosure at all, let alone "replacing the retrieved tag of non-disclosure with the tag for compulsory disclosure," as recited in claims 4 and 6. Claims 4 and 6 are thus also submitted to be allowable. Withdrawal of the rejection of claims 4 and 6 is earnestly solicited.

Claim 7:

Claim 7 recites:

Replacing the character string of non-disclosure with a meaningless character string according to said reason, when there is said character string of non-disclosure in said dictionary.

Anderson neither teaches, discloses, nor suggests "replacing the character string of non-disclosure with a meaningless character string according to said reason, when there is said character string of non-disclosure in said dictionary," as discussed above with respect to the rejections of claims 3 and 5. Claim 7 is thus submitted to be allowable for at least those reasons discussed above with respect to the rejections of claims 3 and 5. Withdrawal of the rejection of claim 7 is earnestly solicited.

Claim Rejections - 35 U.S.C. § 103:

Claims 1 and 2 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Anderson. The rejection is traversed. Reconsideration of the rejection is earnestly solicited.

The second clause of claim 1 recites:

Storing a dictionary which contains said at least one character string of non-disclosure in association with at least one corresponding reason.

Anderson neither teaches, discloses, nor suggests "storing a dictionary which contains said at least one character string of non-disclosure in association with at least one corresponding reason," as discussed above with respect to the rejections of claims 3 and 5.

Anderson, rather, mentions no dictionary at all.

The third clause of claim 1 recites:

Embedding a tag of non-disclosure and the reason of non-disclosure corresponding to the character string in the XML formatted document according to said dictionary.

Anderson neither teaches, discloses, nor suggests "embedding a tag of non-disclosure and the reason of non-disclosure corresponding to the character string in the XML formatted document according to said dictionary," as recited in claim 1. Anderson, rather, mentions no "tag of non-disclosure," "reason of non-disclosure corresponding to the character string," or "XML formatted document" at all. The Office Action notes in the first paragraph at page 5 that "the document of Anderson et al. is not disclosed as being formatted in XML," and asserts that:

However, XML formatting is a well-known, hence obvious, markup language to use in formatting an electronic document, and of visual notice to that effect is hereby taken.

The Applicant respectfully traverses the Examiner's statement and demands the Examiner produce authority for the statement. The Applicant specifically points out the following errors in the Examiner's action.

First, the Examiner uses common knowledge as the principal evidence for the rejection. As explained in M.P.E.P. § 2144.03(E):

any facts so noticed should . . . serve only to 'fill in the gaps' in an insubstantial manner which might exist in the evidentiary showing made by the Examiner to support a particular ground of rejection. It is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based.

Second, the noticed fact is not considered to be common knowledge or well-known in the art. In this case, the limitation is not of notorious character or capable of instant and unquestionable demonstration as being well-known. Instead, this limitation is unique to the present invention. See M.P.E.P. § 2144.03(A) ("the notice of facts beyond the record which may be taken by the Examiner must be "capable of such instant and unquestionable demonstration as to defy dispute").

Third, there is no evidence supporting the Examiner's assertion. See M.P.E.P. § 2144.03(B) ("there must be some form of evidence in the record to support an assertion of common knowledge").

Fourth, it appears that the Examiner also bases the rejection, at least in part, on personal

knowledge. The Examiner is required under 37 C.F.R. § 1.104(d)(2) to support such an assertion with an affidavit when called for by the Applicant. Thus, Applicant calls upon the Examiner to support such assertion with an affidavit.

The fourth clause of claim 1 recites:

Replacing the character string to which the tag of non-disclosure is given to a meaningless character string, when the document is accessed.

Anderson neither teaches, discloses, nor suggests "replacing the character string to which the tag of non-disclosure is given to a meaningless character string, when the document is accessed," as discussed above with respect to the rejections of claims 3 and 5, either. Claim 1 is thus submitted to be allowable, for at least those reasons discussed above with respect to the rejections of claims 3 and 5. Withdrawal of the rejection of claim 1 is earnestly solicited.

Claim 2 depends from claim 1 and adds further distinguishing elements. The last clause of claim 2, for example, recites:

Replacing the retrieved tag of non-disclosure with the tag for compulsory disclosure.

Anderson describes no *compulsory* disclosure at all, let alone "replacing the retrieved tag of non-disclosure with the tag for compulsory disclosure," as recited in claim 2. Claim 2 is thus also submitted to be allowable. Withdrawal of the rejection of claim 2 is earnestly solicited.

Conclusion:

Accordingly, in view of the reasons given above, it is submitted that all of claims 1-7 are allowable over the cited references. There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

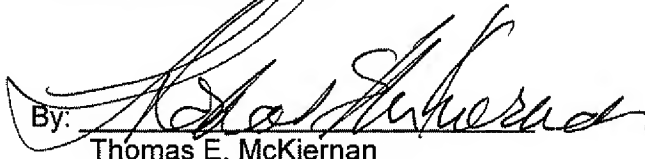
Serial No. 10/749,377

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: 08/14/07

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